

Rejection Under 35 U.S.C. § 112

Claims 7-9 and 13 are rejected under 35 U.S.C. §112 in that the terms “may reversibly retain” and “may receive” are indefinite. Applicant has amended claims 7, 9 and 13 to instead recite “reversibly retains” and “reversibly receives.” Applicant submits that these amendments to the claims overcome this basis for rejection.

Rejection Under 35 U.S.C. § 103

Claims 7 - 13 are rejected as unpatentable over Mackie. Claim 10 is deleted by way of this Amendment. The Examiner characterizes Mackie as disclosing a utility knife with a two halve housing; a retractable blade; a tape measure with a ruler and tab in parallel alignment and a hook in the housing. The Examiner states that although Mackie does not disclose hooks on each half of the housing, such hooks would have been obvious to one of ordinary skill in the art.

Applicant has amended the claims to delete the “adapted to perform a function” language discussed by the Examiner in part 5 of the Office Action (paper no. 6), and has inserted positive limitations that clarify (i) that the claimed invention has a total of two parts (being the two halves of the housing of the knife of the invention), (ii) that the hook is positioned between the blade and the back end of the housing, and (iii) that the hook of the invention is bi-directional.

Applicant respectfully traverses this basis for rejection since Mackie does not disclose a knife having a hook that is not a separate piece, or a bi-directional hook, or a hook that permits insertion of the blade up to the housing. Applicant further asserts that the bi-directional hook of Applicant’s invention is not obvious. In light of the amendments to the claims and the arguments set forth below, Applicant respectfully submits that this basis for rejection may be withdrawn.

Mackie discloses a utility knife with a hook attachment, where the knife must be disassembled and the attachment *inserted partially alongside the blade* of the knife, then the knife is reassembled. In order to change the side that the tape measures on, the user must again disassemble the knife, put the hook on the other side, and reassemble the knife. In addition, when using the hook of Mackie, the blade cannot be inserted to its full depth, as the hook of Mackie rests alongside the blade (as shown in figures 1 - 3 and as described throughout the specification, for instance in Col. 2, lines 30 -33 and 50 - 55. In

the invention of Mackie, bi-directionality could only be accomplished by inserting two of the hooks of Mackie's invention, which would create a very thick profile (which may be uncomfortable to the user) and which may require lengthening of the screws that come with a standard utility knife to accommodate the thickness of both pieces.

Applicant describes and claims (as amended) a utility knife having an angled hook located between the front and the back of the housing for holding a measuring tape tab which, by virtue of the hook location and design, can be used for measuring to the right or left without disassembly or reassembly, which holds the tape in approximately parallel orientation and close to the surface to be cut, which does not require the use of small parts and which accommodates a variety of tab sizes, and which does not increase the profile of the knife. These advantages are described in throughout the Specification and specifically at pages 4 and 5.

In contrast to Mackie, Applicant's invention describes a hook that is part of the knife housing, obviating the need to carry a separate piece or disassemble/reassemble the knife. Moreover, by juxtaposing the two hooks in the housing to form a single opening in the assembled knife, Applicant's invention retains a slim profile in that no thickness is added, in contrast to Mackie. Applicant asserts that this feature is not obvious, as it is more than a routine duplication of parts - it is a fundamental design change which provides Applicant's invention with significant improvements over Mackie, namely, retention of the standard profile and no need to disassemble/reassemble.

Also in contrast to Mackie, the knife of the invention permits the blade to be inserted close to the surface to be cut (i.e. to the full depth of the blade). This feature overcomes one of the significant limitations in the prior art including Mackie (as discussed on p. 2 of Applicant's specification) since the hook of the invention does not limit the depth of cutting, as does the hook described by Mackie.

Accordingly, Mackie does not teach a bi-directional hook, a two-part combined hook and housing, or a hook located between the blade and rear end of the housing, as now claimed by Applicant. Thus, Mackie does not render Applicant's invention obvious, and the Examiner's rejection of claims 7-9 and 11-13 may be withdrawn. Reconsideration of these claims is respectfully requested.

Sincerely,

ARIE DEGABLI Arie Degabli

Arie Degabli